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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,261	12/19/2000	Gary R. McLuen	NEI-00103	7751

7590

12/14/2005

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EXAMINER
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SINES, BRIAN J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,261

Applicant(s)

MCLUEN ET AL.

Examiner

Brian J. Sines

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/22/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-26 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-26 and 35-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

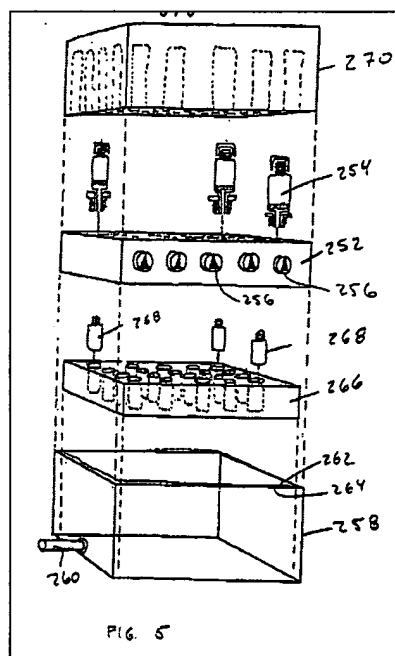
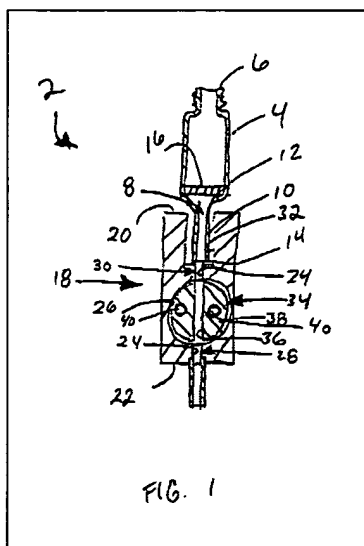
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 24 – 26 & 35 – 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Zuckermann et al. (WO 98/10857) (hereinafter “Zuckermann”).

Regarding claims 24, 35, 38, 40 & 41, Zuckermann teaches an apparatus comprising: a pressurizing system (vacuum manifold 258); a first and second bank of vials (reaction vessel denoted by 2, 4 & 254) disposed in rack 252; and a tube (protruding elongate conduit 10) capable of engaging a selective one of the drains from either the first or second bank of vials (see pages 7 – 15; figures 1 – 5).

Regarding claims 25, 36, 37 & 41, Zuckermann teaches the incorporation of a sealing means (see pages 10 & 11).

Regarding claims 26, 39 & 42, Zuckermann teaches that each reaction vessel 2 comprises a tube (protruding elongate conduit 10) (see figure 1)



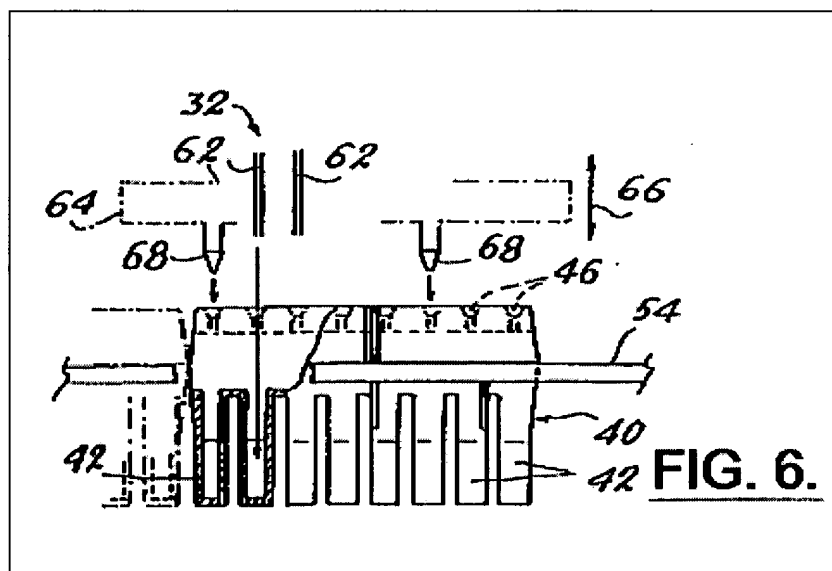
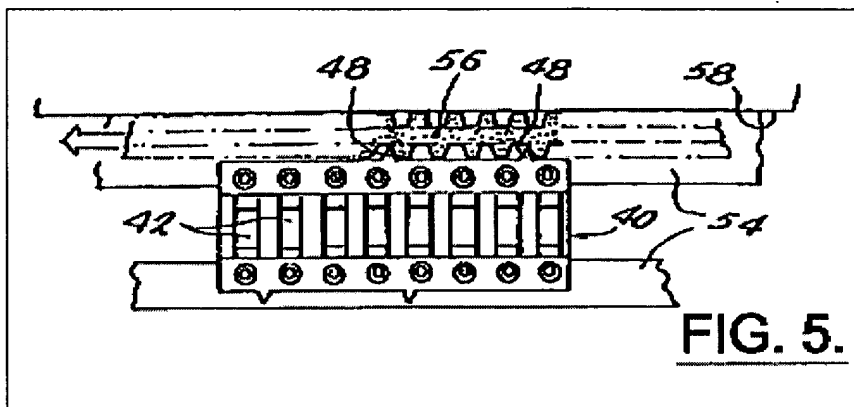
2. Claims 24, 26, 35 & 38 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Uzan et al. (U.S. Pat. No. 5,849,247 A) (hereinafter “Uzan”).

Regarding claims 24, 35, 38 & 40, Uzan teaches an apparatus comprising: a pressurizing system ( suction or injection means); a first and second bank of reaction modules 40 comprising reaction wells or vials 42; and a tube or vertical needle 62 capable of engaging a selective one of

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the drains (tapered orifice 46) from either the first or second bank of vials (see col. 3, line 21 – col. 5, line 50; figures 1 – 11).

Regarding claims 26 & 39, Uzan teaches the incorporation of more than one tube or vertical needle 62 (see figure 6).

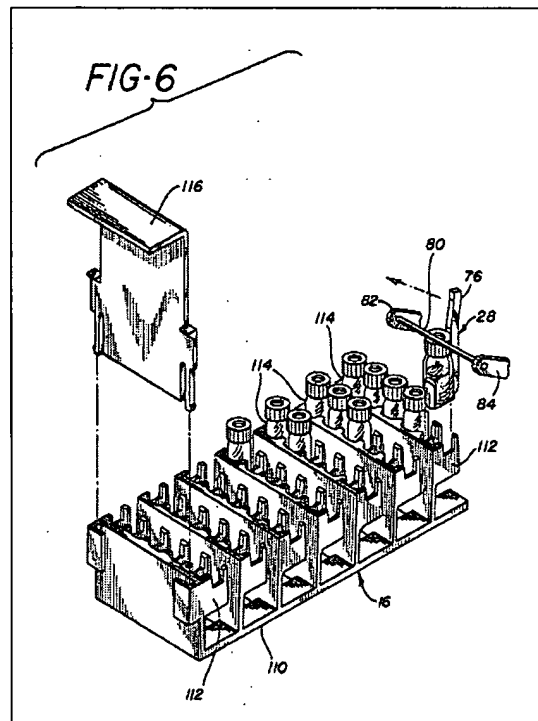


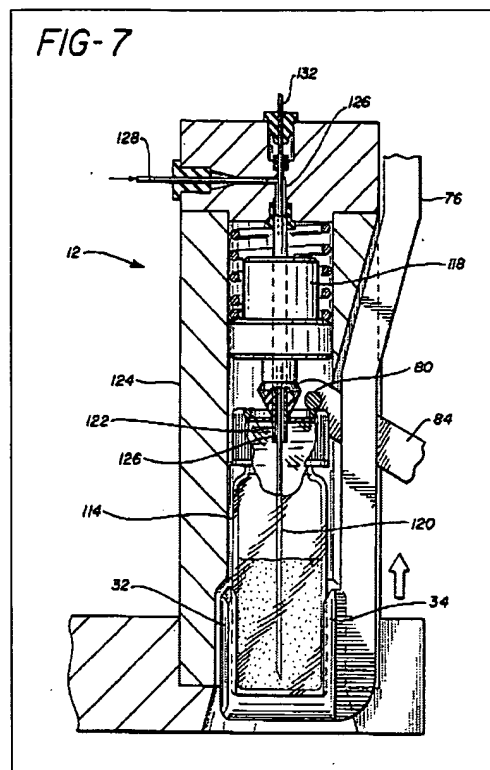
3. Claims 24, 35, 38 & 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. Pat. No. 5,483,843 A) (hereinafter "Miller").

Regarding claims 24, 35 & 38, Miller teaches an apparatus comprising: a pressurizing system (a syringe); a first and second row or bank of vials 114 in vial storage tray 16; and a

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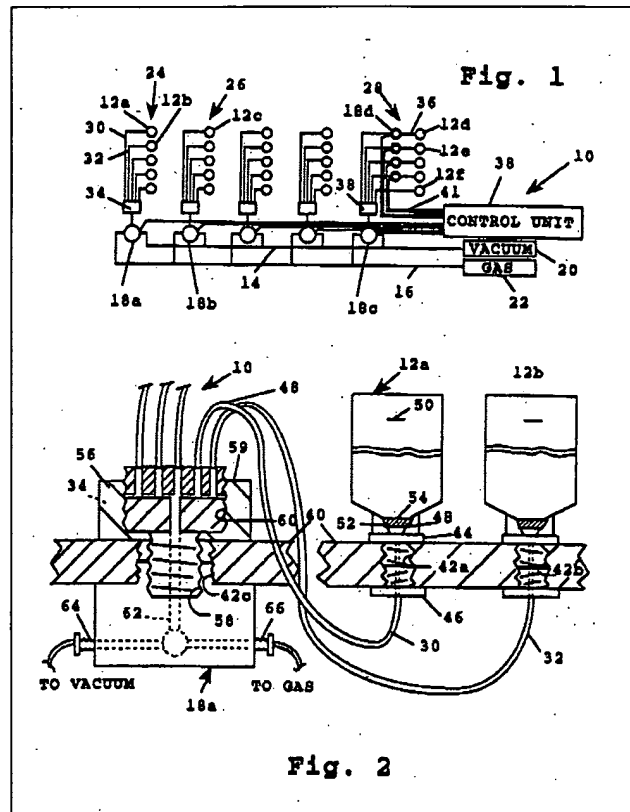
sampling needle or tube 120 capable of engaging a selective one of the drains (the hole in the cap of the vial 114 through which the sampling needle 120 extends) from either the first or second bank of vials (see col. 7, lines 62 – 66; figures 1 – 7).





4. Claims 24 – 26 and 35 – 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckermann et al. (U.S. Pat. No. 5,252,296 A) (hereinafter “Zuckermann”).

Regarding claims 24, 26, 35 and 38 – 42, Zuckermann teaches an apparatus comprising: a pressurizing system (e.g., vacuum source 20 & compressed gas source 22); a first and second tubes (tube 30 or 32) capable of engaging a drain of a plurality of vials (e.g., vessels 12a – 12f). As shown in figure 1, the apparatus comprises a plurality of sets or banks of vials (sets 24, 26 and 28) (see col. 4, lines 30 – 63; figures 1 - 4).



Regarding claims 25, 36, 37 and 41, Zuckermann teaches the incorporation of a Teflon Luer-Lok™ seal fittings for ensuring proper tube connection (see col. 5, lines 12 – 64).

### *Response to Arguments*

Applicant's arguments filed 9/22/2005 have been fully considered but they are not persuasive. The applicant alleges that the cited prior art do not teach the claimed invention. However, as discussed above, the cited prior art do teach all of the positively recited structure of the claimed apparatus. The cited prior art do teach features, e.g., tubes, having the capability of being used in the manner recited. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Courts have held that it is well settled that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See



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*In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The Courts have held that a statement of intended use in an apparatus claim fails to distinguish over a prior art apparatus. See *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Furthermore, the Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP § 2114).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

